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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/692645

Filing Date: 10/19/2000

Appellant(s): Edward M. Housel

Brian R. Harris
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 12/26/2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issue*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-5, 7-25, and 27-30 stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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5,263,129	Ikegaya et al.	11-1993
5,442,732	Matysek et al.	08-1995
5,798,738	Yamada	08-1998
5,878,237	Olarig	03-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. (U.S. Patent # 5,442,732)

Regarding claims 1, and 5: Chen et al. teach a method of performing setup operations (column 3, lines 1-10, column 4, line 29) on a finishing device (20, 22, column 3, lines 1-10, fig. 1) connected to an electrophotographic printer, (10, fig. 1) the printer comprising the steps of: a) entering a print job (column 3, lines 17-40) into the printer, the print job including setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) written as an operator message; (column 4, lines 4-25) b) automatically supplying setup operations to be performed prior to completing the print job; (column 4, lines 10-20) c) automatically placing all pending print jobs on hold that specify the finishing device; (column 4, lines 20-25, 29, fig. 2); d) performing the setup operations according to supplied instruction; (column 4, lines 29-32); and e) entering a release code (the program code that control the

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branching from 44 to 42, fig. 2) to thereby release the print job from hold and allow the printer to complete the print job (column 3, lines 23-25)

Chen et al. do not teach printing an instruction sheet listing setup operations.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Chen et al. as modified by Ikegaya still do not teach a printer user interface.

Matysek teaches a printer (8, fig. 1) having a printer user interface (62, 52, 64, and 66, fig. 1).

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system as modified by Ikegaya by: providing the printer with a printer user interface.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system as modified by Ikegaya by the teaching of Matysek because of the following reasons: (a) it would have allowed users to control the printer at the location of the printer; and (b) it would have allowed users to set up job parameters such as the quantity of prints, and finishing selections, as taught by Matysek at column 1, lines 10-25.

Claims 9, 13, 17, 21, 25, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129)

Regarding claims 9 and 13: Chen et al. teach a method of managing a printer system, (fig. 1) comprising the steps of: a. receiving a print job; (29, fig. 2); b. determining whether the print job specifies a finishing device (20, 22, column 3, lines 5-15) and whether the print job includes instructions directing an operator (column 4, lines 8-35, 40, fig. 2) to perform specific setup operations and, if so, placing on hold all print jobs that specify the finishing device; (column 4, lines 20-25, 29 of fig. 2); c. performing the setup operations sheet; (column 4, lines 29-32) and d.

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entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet listing setup operations to be performed by the operator.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations to be performed by the operator.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 17: Chen et al. teach a method of managing a printer system, (fig. 1) comprising the steps of: a. setting up a print job (fig. 2) using a setup menu that includes an instruction field in which operator setup instructions may be entered; (column 4, lines 10-20) b.

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submitting the print job to the printer; (28, fig. 2) c. determining whether any text (setup instruction, column 4, line 10-24) has been entered in the instruction field and, (column 4, lines 25-32) if so, placing all print jobs on hold; (print job is held on 29, fig. 2, before post processor is being set up in 44, fig. 2) d. performing one or more setup operations; (44, fig. 2) and e. entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by

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Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 21. Chen et al teach a method of managing a printer system, (fig. 2) comprising the steps of: a. receiving a print job; (29, fig. 2) b. determining that the print job includes operator instructions; (40, fig. 2) c. automatically placing the print job on hold (print job is not passing 44 before post processor is being set up) while allowing other print jobs to continue; (other job is stored in 29, fig. 2) d. performing operations specified by the operator instructions; (44, fig. 2) and e. entering a code that removes the hold, allowing the print job to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet corresponding to the operator instructions.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet corresponding to the operator instructions;

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily

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and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 25: Chen et al. teach a method of coordinate a printer (10, fig. 1) and an associated finishing device (20, 22, column 3, lines 1-10, fig. 1) that is connected to the printer, (10, fig. 1) comprising the steps of: a) receiving, at the printer, a first print job (column 3, lines 17-40); the first print job, before sending to the printer, including received setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) that is associated with the first print job; (b) supplying setup instructions, the instruction listing setup operations associated with the first print job, the setup operations to be performed on the at least one finishing device prior to completing the print job; (column 4, lines 10-32) c) placing at least the first print job on hold; (the print job is not printed before the setup instructions were presented to the operator, column 4, lines 29-32); and d) entering a release code (the program code that control the branching from 44 to 42, fig. 2) to thereby release the print job from hold and allow the printer to complete the print job (column 3, lines 23-25)

Chen et al. do not teach printing an instruction sheet listing setup operations, and receiving at the printer, the setup instructions as part of the printing job.

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Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: using the printer of Chen for printing an instruction sheet listing setup operations. (After the combining of Chen and Ikegaya, the printer of Chen would be used to print an instruction sheet listing setup operations supply from a host. Therefore, the printer would receive the setup instructions as part of the printing job).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 29: Chen teaches placing at least the first print jobs on hold comprising placing all print jobs on hold. (See the operator performs the hardware setup first before print job is being sent. When the operator does not received setup instruction and does not setup hardware, print jobs are not sent)

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Regarding claim 30: Chen teaches placing at least the first print jobs on hold comprising placing on hold any print jobs that require using the at least one finishing device that is associated with the first print job. (See the operator performs the hardware setup first before a print job is being sent. When the operator does not receive setup instruction and does not setup hardware, print jobs are not sent)

Claims 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. as applied to claims 1, 5, above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 3, and 7: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the print job is entered through a network.

Yamada teaches to enter print jobs (column 5, lines 60-61, column 14, line 2) to a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by entering the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed

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users to sent print jobs to remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to send print jobs to different printers; and (c) it would have allowed users to print the print jobs with other printers while a printer is down in the network.

Regarding claims 4, and 8: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

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Claims 11, 12, 15, 16, 19, 20, 23, 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 11, 15, and 27: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is received from a network.

Yamada teaches to receive print jobs (column 5, lines 60-61, column 14, line 2) by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by receiving the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print jobs using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print jobs to different printers; and (c) it would have allowed users to print jobs with other printers while a printer is down in the network.

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Regarding claims 12, 16, 20, 23, and 28: Chen et al. in view of Ikegaya et al. do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

Regarding claims 19 and 24: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is set up on a network.

Yamada teaches to set up print jobs (column 5, lines 60-61, column 14, line 2) to be printed by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by setting up the print job on a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print jobs using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print jobs to different printers; and (c) it would have allowed users to print jobs with other printers while a printer is down in the network.

Claims 10, 14, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Olarig (U.S. Patent # 5,878,237).

Regarding claims 10, 14, 18, and 22: Chen et al. do not teach wherein at least some of the instructions for setup operations are stored on a memory.

Ikegaya teaches to store the setup instructions in a memory (column 3, lines 1-10)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. by: storing the setup instructions in a memory

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. by the teaching of Ikegaya because of the following reasons: (a) storing the setup instruction by a memory would have prevented the setup instruction being lost, and users would save time for not having to write the setup instruction every time the system is to be setup.

Chen et al as modified by Ikegaya still do not teach storing the instructions in a local disk.

Olarig teaches to use a local disk as a memory for storing information (column 15, lines 15-20).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al as modified by Ikegaya by: replacing the memory used to store the setup instruction by a local disk.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al as modified by Ikegaya by the teaching of Olarig because of the following reasons: (a) a hard disk would have allowed the printer system to save data from losing even when the power to the system is being turned off; and (b) a hard disk is more durable compared to a tape or a floppy disk, and thereby, allowing the system to last longer.

(11) Response to Argument

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Appellant, on the top of page 8, brief, argues that none of the references suggests automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job.

In response: Chen et al, column 4, lines 10-33, teaches to automatically generate an instructing list of set up operations such as changing the paper cutting knife position, changing the color plate used in fixed printing, to be performed by an operator prior to sending the print job to the presentation services program. (Prior to completing the print job)

Chen et al. do not teach printing an instruction sheet listing the setup operations (such as changing the paper cutting knife position, changing the color plate used in fixed printing) to be performed by the operator.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to

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avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Appellant, on the bottom of page 8, and the top of 9, brief, argues that none of the references suggests entering a print job into a printer, the print job including setup instructions for at least one finishing device written as an operator message.

In response: Chen et al teaches entering a print job into a printer by entering medium modifications specifying the operation to be performed on the printed medium (column 3, lines 30-58) such as simplex printing, offset stacking for job separation; and to identify operations to be performed by the post printer processor (finishing device) such as perforation, fanfolding, and cutting. (column 3, lines 3-10, column 3, lines 58-67, column 4, lines 1-5) The print job includes setup instructions (column 4, lines 10-25) listing jobs to be performed on the post processor (finishing device) by an operator such as changing the paper cutting knife positions, and changing the color plates.

Appellant, on the middle of page 9 and the bottom of page 11, brief, argues that Ikegaya does not show or suggest automatically printing an instruction sheet listing setup operation for finishing devices to be performed prior to completing a particular print job; and the top of page 12, brief, argues that Ikegaya fails to show printing setup instructions for finishing devices attached to the facsimile machine.

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In response: As previously discussed, column 4, lines 5-35, Chen et al. teach automatically generating an instruction sheet listing setup operation for finishing devices to be performed by an operator prior to completing a particular print job when the finishing device needed to be set up by an operator.

Chen does not teach that list of setup operation was generated by printing the list.

Ikegaya's reference is used to show that it is well known that instructions for guiding an operator to perform various functions on a device would be printed onto a sheet of paper.
(Column 8, lines 5-15)

The reason for printing the setup operation list/instruction sheet for the operator is because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Appellant, on the middle of page 13, brief, argues that there is no motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art to combine Chen and Ikegaya; on the middle of page 15, brief, argues that there is no need to carry an instruction sheet for Ikegaya; and on the middle of page 16, brief, argues that Chen teaches away from carrying information between the printer and its finishing device.

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In response: Ikegaya, column 8, lines 5-20, teaches printing a required sheet of manual for instructing operators of setting up a fax machine (a fax machine is a type of printer because a fax machine would print information onto a recording medium) such that the setting up of various functions of a fax machine would be effected by operators very easily and in a short time.

Ikegaya, column 1, lines 5-15, and lines 45-50, teaches using printed sheets of manual describing user friendly operation procedures would permit users to execute operations easily, and also the printed instruction sheet would be used in Ikegaya's system to avoid alternately looking at a manual and an operation panel for setting up device and thereby, prevents the move of the operator's line vision back and forth from the manual to the operating panel.

Therefore, Ikegaya suggested the printing of an instruction sheet for the list of set up operations disclosed in Chen's reference to allowed the operator to set up the printing system/finishing device of Chen very easily.

Moreover, a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

It is knowledge generally available to one of ordinary skill in the art that any devices would have a front, a back, a left, a right, a top, and a bottom view. For example, assuming Chen is using a display for displaying the set up instructions and the set up instructions are displayed such that they would be viewed from the front side of the printing system or the finishing device. If an operator would need to set up the printing system/finishing device from

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the back side, the operator would have to go to the front of the display to see the instructions or move the display to a position such that the operator would see the instructions. When the instructions are printed onto a sheet of paper, it would be very easy for the operator to carry the printed instruction sheet to the front, back, left, right, top, and bottom of the printing system/finishing device.

Appellant, on the top of page 16, brief, argues that Chen teaches to use post processor control data to direct modifications to be made to the printer sheet so that carrying an instruction sheet is not required.

In response: Column 4, lines 10-30, Chen, teaches to have an operator to set up the printing system including post processor/finishing device, following instructions given to the operator, while entering a print job into a printer. The benefit of using a printed instruction sheet has been discussed.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

King Y. Poon

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March 7, 2003

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